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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,077	02/05/2004	Patrick J. Treado	030687	6027
41396	7590	06/03/2004		
DUANE MORRIS LLP P. O. BOX 1003 305 NORTH FRONT STREET, 5TH FLOOR HARRISBURG, PA 17108-1003			EXAMINER LAUCHMAN, LAYLA G	
			ART UNIT 2877	PAPER NUMBER

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/773,077	TREADO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	L. G. Lauchman	2877	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### **Disposition of Claims**

4)  Claim(s) 12-14, 17, 21 and 22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 12, 14, 17, 21 and 22 is/are rejected.

7)  Claim(s) 13 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 2/05/2004 is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Amendment***

The Declaration filed on 2/05/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the reference US 6,571,117. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the '117 reference. A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). If the applicant made sketches he should so state, and produce and describe them. (MPEP 715.07 Facts and Documentary Evidence). The applicants fails to sufficiently explain how the records from the submitted laboratory notes overcome the '117 reference. The examiner could not find in the records the description of the system comprising a near infrared imaging detection system and a visible imagery system as claimed. Therefore, the rejection 102(e) is maintained.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 recites the limitation "the objective" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Marbach (US 6,571,117).

As to Claim 12, Marbach teaches an imaging measuring system comprising a near infrared imaging detection system and a visible imagery system (see Fig. 1a, col. 7, lines 18-67, and col. 8, lines 1-5)

As to Claim 14, Marbach teaches everything as applied to claim 12 above, and an illumination source (13) for illuminating an area of a sample using light in the visible wavelength; and a device 22 for detecting said visible wavelength from said illuminated area of said sample.

Claim 17 is rejected under 35 U.S.C. 102(e) as being anticipated by MacAulay (US 6,483,641).

MacAulay teaches a method of reconstruction a 3D-image (see Figs. 10a, 10b, and 11) comprising, moving a sample 20 along an objective 22; collecting images of said sample through said objective in a plurality of focus depths (Fig. 11), and

processing said collected images to reconstruct an image of said sample (see col. 23, lines 53-67, col. 24, lines 1-17).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Marbach (US 6,571,117) as applied to Claim 12 above.

The patent teaches all as applied to Claim 12, except for that the visible imagery system comprises a microscope and a macroscope. However, the use of those is well known in the art of visible imagery systems (see US 5,645,550).

Claim 17 is rejected under 35 U.S.C. 102(e) as being unpatentable over Johnson (US 6,392,752).

The patent teaches a method of producing an image of a sample, comprising: moving a sample 106 along an objective 101; collecting images of said sample through said objective in a plurality of focus depths, and processing said collected images to reconstruct an image of said sample (see col. 3, lines 31-56).

***Allowable Subject Matter***

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record taken along or in combination, fails to disclose or render obvious an algorithm for processing the near infrared and visible image data, in combination with the rest of the limitations of the independent Claim 12 and all of the limitations of Claim 13.

***Response to Arguments***

Applicant's arguments filed 2/05/2004 have been fully considered but they are not persuasive. The applicants state that claims 12 and 14 teach the combination of features detected using optical imaging with the spectral features found through NIR. However, Marbach teaches use of optical imaging integrated with non-invasive measurement in NIR wavelength range by utilizing a visible imagery system and NIR imaging detection system, as it is stated in Claim 12.

Applicant's arguments with respect to claim 17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. Papers should be faxed to TC 2877 via the PTO Fax Center located in CP4-4C23. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CP4 Fax Center number is (703) 872-9306.

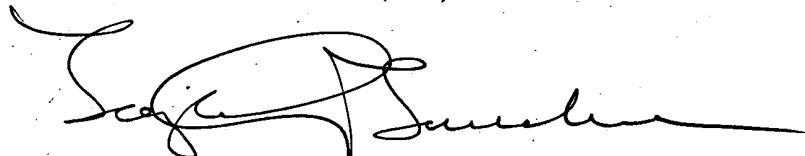
If the Applicant wishes to send a Fax dealing with either a Proposed Amendment or for discussion for a phone interview then the fax should:

- a) Contain either the statement "DRAFT" or "PROPOSED AMENDMENT" on the Fax Cover Sheet; and
- b) Should be unsigned by the attorney or agent.

This will ensure that it will not be entered into the case and will be forwarded to the examiner as quickly as possible.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to L. G. Lauchman whose telephone number is (571) 272-2418.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC receptionist whose telephone number is (571) 272-1562.



L. G. Lauchman  
Patent Examiner  
Art Unit 2877  
May 26, 2004